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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,768	05/18/2006	Satoshi Mihara	21713-00058-US1	3575
30678 7590 08/27/2009 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER				
BUIE, NICOLE M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
08/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,768

Applicant(s)

MIHARA ET AL.

Examiner

NICOLE M. BUJE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 06/08/2009 has been entered. Claims 4-8 remain pending. The previous objection to claims 1 and 4-8 are withdrawn in light of Applicants' amendment and cancellation of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cruse et al. (US 2002/0055568).

Regarding claims 4 and 5, Cruse et al. discloses silane coupling agents (i.e. “3-trimethoxysilyl-1-propyl thiooctanoate”, “3-triethoxysilyl-1-propyl thiooctanoate”, [0030], claim 1). Cruse et al. discloses about 0.05 to about 20 of at least one silane coupling agent based on the amount of inorganic filler which meets the claimed range [0074]. Cruse et al. discloses adding silane to the silica before adding the rubber [0045]. Cruse et al. discloses a rubber composition comprising a rubber component containing 100 parts by weight of at least one conjugated diene-based rubber and 5 to 100 parts by weight of surface-treated silica treated, on its surface in advance, with a silane coupling agent [0070]-[0074]. (Since Cruse et al. teaches similar compounds for treating the silica and method of adding the surface treatment agent (See

[0016-0017] of the corresponding PG Pub), the bulk density retention rate would be inherently possessed by the composition of Cruse et al., absent objective evidence to the contrary).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 4 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4 and 6 in view of claim 9 of copending Application No. 11/573619.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application '619 recites a silane-coupling agent-treated silica where the silane coupling agent includes 3-triethoxysilylpropyl thioacetate, 3-trimethoxysilylpropyl thioacetate, 3-octanoylthiopropyl trimethoxysilane, or 3-octanoylthiopropyl tripropoxysilane

(claim 2). Application '619 also recites 1 to 50 parts by mass of silane coupling agent (claim 1). Since the silica is treated with an overlapping amount of silane coupling agent, the silica would inherently possess the bulk density of Application '619. (Since Application '619 describes similar compounds for treating the silica and method of adding the surface treatment agent (See [0016-0017] of the corresponding PG Pub), the bulk density retention rate would be inherently possessed by the composition of Cruse et al., absent objective evidence to the contrary).

Application '619 recites a similar rubber composition wherein the claimed amount of surface treated silica overlaps the instant claimed range (claims 4 and 6)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 06/08/2009 have been fully considered but they are not persuasive. The following comments apply:

A) Applicants' argument that the use of pre-treated silica having a bulk density retention of 50-150, as a silane-coupling agent, with a diene-based rubber in the rubber composition is not disclosed by Cruse (P5) is not persuasive. As shown above in claim 4, Cruse discloses a composition which meets the claimed limitations.

B) Applicants' argument that the use of pre-treated silica in a rubber composition is not exemplified in Cruse (P6) is not persuasive. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed.

Cir.), *cert. denied*, 493 U.S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). When preparing treated silica, there are really only two options for doing so, at least where the timing of the treatment is concerned: (i) to treat it before adding it to the polymer host, (ii) to treat it in situ in the presence of the polymer host. Because there are only two treatment options, both are readily envisaged. Couple this with the express mention of this possibility in [0081] and there can be little argument that this aspect is anticipated.

C) Applicants' assertion of unexpected results (P5) is not persuasive. Since claim 1 is anticipated by Cruse et al, showing of unexpected results is immaterial.

D) Applicants' argument that the provisional rejection of claim 4 is not deemed tenable since the present application was filed prior to US Patent Application 11/573619 (P7) is not persuasive. The provisional double patenting rejection is maintained, since there are conflicting claims in the copending application until the provisional double patenting rejection is the only rejection remaining. The sulfur deviation is not a required limitation of the instant claims, therefore the sulfur deviation of the copending claims is not germane. Although the copending claims do not recite the bulk density retention of 50-150%, Application '619 describes similar compounds for treating the silica and method of adding the surface treatment agent (See [0016-0017] of the corresponding PG Pub), the bulk density retention rate would be inherently possessed by the composition of Cruse et al., absent objective evidence to the contrary.

Allowable Subject Matter

Claims 6-8 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./
Examiner, Art Unit 1796
8/17/2009

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796